

The opinion in support of the decision being
entered today is not binding precedent of the Board.

Paper 9

Filed by: Trial Section Motions Panel
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

Filed: August 3, 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

KAZUhide HAYAMA, KANJI NARAZAKI, YUKIO SAITOH,
TOMOAKI HIWATASHIH, ISAO ITOH, SIGEOKI KAWAGUCHI
Junior Party,
(Patent 5,362,485)
v.

KANTA KUMAR, RAMESH C. KUMAR,
SMARAJIT MITRA
Senior Party
(Application 08/460,958).

Patent Interference No. 104,725

Before: SCHAFFER, TORCZON and TIERNEY, Administrative Patent Judges.
TIERNEY, Administrative Patent Judge.

JUDGEMENT AND RECOMMENDATION
(Pursuant to 37 CFR § 1.662(a) and § 1.659(c))

A. Judgment

A conference call took place on July 31, 2001 between a representative of Oblon, Spivak, McClelland, Maier & Neustadt and Ms. Sonja Desperth, an interference trial section paralegal. During the conference call, the Oblon, Spivak representative informed Ms. Desperth that Junior Party Hayama would not be contesting the interference. This abandonment of contest is

consistent with Junior Party Hayama's failure to comply with sections 6 and 7 (identification of counsel and real party in interest) as set forth in the Standing Order (Paper No. 2). Pursuant to 37 CFR § 1.662(a), Junior Party Hayama's abandonment of the contest is treated as a request for adverse judgment as to Count 1.

B. Recommendation

It is recommended that the examiner of Kumar et al., U.S. Patent Application 08/460,958 (Kumar '958) reject claims 115-117, 120, 122-125, 128-136, 140-145 under 35 U.S.C. § 112, first paragraph, written description. Specifically, it is not clear to us that the Kumar '958 application directs or guides one skilled in the art to the polysiloxanes recited in claims 115-117, 120, 122-125, 128-136, 140-145.

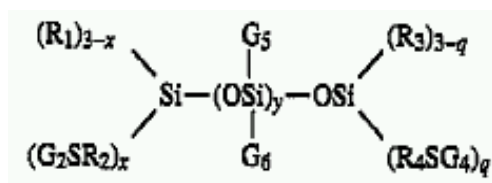
The purpose of the written description requirement is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by the inventor. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). The inventor can demonstrate possession by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention. The inventor, however, needs to show that the inventor was "in possession" of the invention by describing the invention, with all its claimed limitations, not that which makes it obvious. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1571, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

The disclosure as originally filed does not have to provide *ipsis verbis* support for the claimed subject matter at issue. *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323, 56

USPQ2d 1481, 1483 (Fed. Cir. 2000); *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996). Rather, if the written description does not use precisely the same terms used in a claim, the question then is whether the specification directs or guides one skilled in the art to the subject matter claimed such that the specification reasonably conveys to those skilled in the art that the inventor invented what is claimed. *See, e.g., Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116; *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989).

While the specifics of the cases concerning adequate written description vary, the cases agree that the inquiry is *factual* and must be assessed on a *case-by-case* basis. *See, Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 989, 1000, 54 USPQ2d 1227, 1235 (Fed. Cir. 2000); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). Accordingly, we have reviewed the Kumar ‘485 application and its prosecution history in light of the facts before us.

The Kumar ‘958 application was filed on June 5, 1995 with claims 1-58. The Kumar ‘958 application states that the “present invention relates to cosmetic compositions containing a vinyl-silicone graft or block copolymer.” (Kumar ‘958, p. 1, lines 9-11). According to Kumar ‘958, the copolymer used in the invention is represented by the following formula (A):



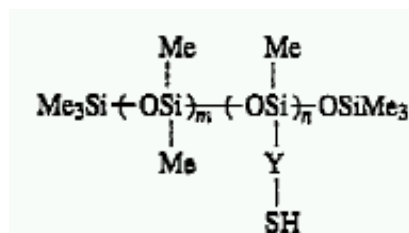
Focusing on the middle portion of the above formula, y , G_5 , G_6 are as follows:

G_5 represent monovalent moieties which can independently be the same or different selected from the group consisting of alkyl, aryl, alkaryl, alkoxy, alkylamino, fluoroalkyl, hydrogen, and -ZSA; A represents a vinyl polymeric segment consisting essentially of polymerized free radically polymerizable monomer, and Z is a divalent linking group. Useful divalent linking groups Z include but are not limited to the following: C_1 to C_{10} alkylene, alkarylene, arylene, and alkoxyalkylene. Preferably, Z is selected from the group consisting of methylene and propylene for reasons of commercial availability. (Kumar '958, p. 8, lines 21-34).

G_6 represents monovalent moieties which can independently be the same or different selected from the group consisting of alkyl, aryl, alkaryl, alkoxy, alkylamino, fluoroalkyl, hydrogen, and -ZSA. . . (Kumar '958, p. 8, lines 35-38).

y is an integer of 5 or greater; preferably, y is an integer ranging from about 10 to about 270 in order to provide the silicone segment with a molecular weight ranging from about 750 to about 20,000. Most preferably, y is an integer ranging from about 40 to about 270 . . . (Kumar '958, p. 10, lines 10-15 emphasis added).

Additionally, the Kumar '958 application states that preferred polymers of the invention include the reaction product of 35 to 95 weight percent "hard" monomers, 0 to 25 weight percent "soft" monomers, and 5 to 40 weight percent mercapto-functional silicone compounds of the following formula (B):



wherein the mole ratio of m/n is 9-49; and

Y is selected from C1-10 alkylene and alkarylene having at least 10 carbons, wherein the bracketed groups may be randomly distributed throughout the compound, said compound having a total number average molecular weight of 350-20,000.

(Kumar '958, page 25, line 26 to p. 26, line 6).

Kumar '958 was filed with 58 claims. Of the 58 claims, claims 1, 34 and 45 were independent claims. Claim 1 was directed to a composition comprising a graft or block copolymer of formula (A) whereas independent claims 34 and 45 were directed to polymers formed by a reaction involving the mercapto-functional silicone compound (B).

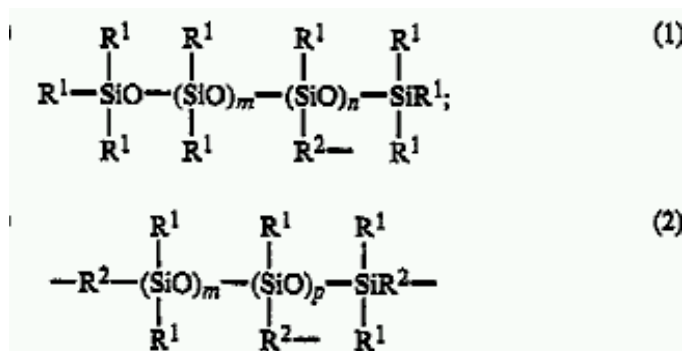
Concurrent with the filing of the Kumar '958 application, Kumar cancelled claims 1-58 and added claims 59-114. (Preliminary Amendment, Paper No. 3). Of claims 59-114, only claims 59 and 98 were independent claims. Claim 59 was directed to a hair cosmetic composition having a graft or block copolymer of formula (A) and claim 98 was directed to a copolymer reaction product involving the mercapto-functional silicone compound of formula (B).

On November 13, 1995, Kumar filed an Amendment that added new claims 115-129. According to Kumar:

The above claims [115-129] correspond exactly to the claims of U.S. Patent No. 5,362,485 to Hayama et al. These claims are submitted at this time so that these claims are on file within one year of the patent grant of the Hayama patent.

(Amendment Under 37 CFR 1.111, Paper No. 5, p. 4). In presenting the Amendment, we note that Kumar offered no guidance as to how the copied claims were supported by the Kumar '958 application.

Claim 115, the only independent claim submitted, related to a hair cosmetic composition comprising a copolymer comprising a first unit containing a polysiloxane group of the general formula (1) and/or (2):



Of note, claim 115 defines m as an integer within a range of from 10 through 350, n being an integer within a range from 1 through 50 and p being an integer within a range of from 0 through 50.

Following a succession of amendments to the claims, Kumar '958 now contains claims 112-117, 120, 122-125, 128-145. Of these claims, claims 115-117, 120, 122-125, 128-136, 140-145 require the presence of a “first unit containing a polysiloxane group of the general formula (1) or (2)” or depend from a claim which requires its presence. (See, e.g., Amendment Under 37 CFR 1.111, Paper No. 27, claim 115, four times amended). Claims 115-117, 120, 122-125, 128-136, 140-145 define m as an integer within a range of from 10 through 350, n being an integer within a range from 1 through 50 and p being an integer within a range of from 0 through 50. In contrast, claims 130-136 define m as an integer within a range of 10 to 270, n as an integer within a range of from 1 through 50 and p being an integer within a range of from 0 through 50.

It is not apparent that one skilled in the art would understand that the inventor invented what is claimed. Specifically, it appears that Kumar lacks written descriptive support for its copied, claimed copolymer comprising a first unit containing a polysiloxane group of the general

formula (1) and/or (2). For example, Kumar provides the following comparison of claim 130 and its alleged support in the Kumar '958 application:

Kumar Claim 130	Kumar '958 Application
and m, n and p represent the numbers of groups contained in each polysiloxane group, m being an integer within a range of from 10 through 270, n being an integer within a range from 1 through 50, and p being an integer within a range of from 0 through 50;	The sum of m, n and p is 11 through 370, which corresponds to y as defined on page 10, lines 10-15, as an integer of 5 or greater, preferably about 10 to about 270, more preferably 40 to 270.

(Amendment Under 37 CFR 1.15 and Submission Under 37 CFR 1.607, Paper No. 13, p. 15).

Kumar's explanation, however, appears insufficient. For example, the sum of m (upper limit 270), and n *or* p (upper limit 50) adds up to 320 as opposed to 370, i.e., formula (I) is the sum of m+n and formula (II) is the sum of m+p. Moreover, Kumar's explanation failed to identify how one skilled in the art is guided to the sum of **11 through 320** for polymer (1)(lower and upper limits m+n) and the sum of **10 through 320** for polymer (2)(lower and upper limits m+p) from a specification that guides one skilled in the art to employ an integer of **5 or greater**, preferably **10 to 270**, more preferably **40 to 270**. More importantly, Kumar did not explain how one skilled in the art is guided to select the ratio of m/n (10-270/1-50) and m/p (10-270/0-50) from a specification that merely refers to a single variable y. While it may be obvious to select the appropriate ranges for m, n and p, "possession" of the invention requires describing the invention, with all its claimed limitations, not that which makes it obvious. *Lockwood*, 107 F.3d at 1571, 41 USPQ2d at 1966.

As the record is unclear as to the written descriptive support for claims 115-117, 120, 122-125, 128-136, 140-145 it is recommended that the examiner reject these claims under

35 U.S.C. § 112, first paragraph, written description. This recommendation is without prejudice to any other rejection the examiner deems necessary during the course of examining the Kumar '958 application.

C. Order

Upon consideration of the record, and for the reasons given, it is:

ORDERED that judgment on priority as to Count 1 (Notice Declaring Interference, Paper No. 1, page 5), the sole count in the interference, is awarded *against* Junior Party Hayama.

FURTHER ORDERED that Junior Party Hayama is not entitled to a patent containing claims 1-15 of Hayama et al., U.S. Patent No. 5,362,485.

FURTHER ORDERED that a copy of this Judgment shall be placed and given a paper number in the file of Hayama et al., U.S. Patent No. 5,362,485 and Kumar et al., U.S. Patent Application 08/460,958.

FURTHER ORDERED that if there is a settlement agreement, attention is directed to
35 U.S.C. § 135(c) and 37 CFR § 1.661.

RICHARD E. SCHAFER)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
RICHARD TORCZON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
MICHAEL P. TIERNEY)	
Administrative Patent Judge)	

cc (via Facsimile):

Attorney for Kumar:

Herbert H. Mintz,
Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
1300 I Street, N.W., Suite 700
Washington, D.C., 20005-3315
Tel: (202) 408-4000
Fax: (202) 408-4400

Attorney for Hayama:

Oblon, Spivak, McClelland, Maier & Neustadt
Fourth Floor
1755 Jefferson Davis Highway
Arlington, VA 22202
Tel: (703) 413-3000